

Appl. No. 10/057,608  
Amendment dated November 5, 2003  
Reply to Office Action of August 6, 2003

**REMARKS**

Applicant and Applicant's representative acknowledge and appreciate the Examiner's courtesy and thoroughness during the personal interview on October 30, 2003. The Examiner's Interview Summary accurately reflects the agreement reached during the interview.

Claims 1, 7 - 10, 17 - 19, 23 - 26, 28 - 29 and 34 - 35 have been amended. Claims 1 - 38 remain in the application and are presented for reconsideration.

The Examiner has rejected claims 1 - 8, 24 - 27, 29 - 31, and 34 - 38 under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which Applicants regard as the invention. The Examiner stated that claims 1 - 8, 24 - 27, 29 - 31, and 36 - 38 are inoperative and therefore lack utility for the recited purpose of the disclosed and claimed invention, since one of ordinary skill would not recognize the process recited in the steps of the claims as processing a plurality of undeliverable mail items as set forth as the intended purpose of the invention.

Independent claims 1 and 24 have been amended by this response. Claim 1 now recites scanning and decoding the encoded data on the items of undeliverable mail to identify intended recipients having incorrect addresses, and electronically transferring to a sender information for the identified intended recipients for the sender to update the sender's mailing address files. Claim 24 has been amended in a similar fashion. This claim now recites a processor for operation of a computer program for identifying the intended recipient identification information in the decoded data, writing the identified recipient identification information into a data file, and transferring to a sender information for the identified intended recipients for the sender to update a sender's mailing

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address files. With these amendments, claims 1 and 24 now recite more specifically the steps and system components that carry out the intended purpose of the invention, i.e., processing of a plurality of undeliverable mail items. The other claims rejected under 35 USC § 112 by the Examiner depend directly or indirectly from either claim 1 or claim 24.

Claims 34 - 35 were rejected under 35 USC § 112, second paragraph, because they were recited as process claims dependent upon article of manufacture claims 19 and 20. Claims 34 and 35 have been amended to recite "computer program product" in the preamble of the claims.

Therefore, in view of the above amendments and arguments, the rejection of claims 1 - 8, 24 - 27, 29 - 31 and 34 - 38 under 35 USC § 112, second paragraph is overcome.

The Examiner rejected claims 19 - 23, 34, and 35 under 35 USC § 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed. In paragraph 4.1.3, the Examiner stated that the invention recited in claims 19 - 23, 34 and 35 merely describes an abstract idea of a disembodied storage device, i.e., memory, that stores a computer program as a non-functional data structure, since a disembodied storage device by itself cannot produce a concrete and tangible result by performing the functions recited within the claims as the invention. The Examiner cited the State Street Bank and Trust Company v. Signature Financial Group, Inc., 47 USPQ 2d 1596 (CAFC 1998). In State Street, the Federal Circuit expressly authorized claims drawn to methods of doing business. The Court simplified the test of patent eligibility as follows: an invention involving some sort of abstract idea may obtain patent protection as long as a claim contains a practical application of that idea. The Court added that patent protection would apply to those inventions producing "a useful, concrete, and tangible result." (State Street 149 F.3d 1368,

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1373). Although the claimed apparatus in State Street only produced a number that simply represented a financial value, the Court found that producing a share price constituted a practical application, meeting the test for statutory subject matter under 35 USC § 101.

Subsequent to State Street, the Court removed the requirement for a "physical transformation" as "an invariable requirement" for subject matter patentability in AT&T Corp. v. Excel Communications, Inc., 172 F. 3d 1352 (Fed. Cir. 1999). The Court suggested that such physical transformation merely provides one example of how a mathematical algorithm may bring about a useful result (Id. at 1358). The Court also removed the requirement that claims describe some sort of physical limitations. The Court discounted the fact that the claim involved a mathematical algorithm because the claimed process of determining the value of the primary inter-exchange carrier (PIC) indicator produced a useful and non-abstract result by facilitating billing.

Claim 19 has been amended to recite that program instructions identify intended recipients having incorrect addresses, and program instructions transmit the updated intended recipient address information to a subscriber electronically to update the address files of the subscriber. Claims 20 - 23, and 34 - 35 depend from claim 19. In the present invention, the processing of undeliverable mail items to identify intended recipients having incorrect addresses and electronically transferring information for the identified intended recipients to a sender for updating the sender's mailing address files is a useful and non-abstract result that enables the sender to resend items such as bills to its customers, and eliminates the very labor intensive task of manually updating individual mailing address records for its customers. In view of the amendments to claim

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19, the rejection of claims 19 - 23, 34 and 35 as directed to non-statutory subject matter is overcome.

The Examiner rejected claims 1 - 4, 7 - 13, 16 - 23, and 28 - 33, under 35 USC § 102(b) as being clearly anticipated by *Sansone, et al.* (U.S. Pat. No. 5,925,864). This rejection is respectfully traversed.

With regard to the rejected claims, the Examiner stated that *Sansone, et al.* disclose a mail processing system that applies both machine readable encoded recipient address information, for example a PDF 417 barcode, and the recipient's address information to an item of mail. The item of mail is then placed in the mail delivery system. When an item of mail cannot be delivered as addressed, the item of mail is returned to the sender and the machine-readable information and recipient address information are acquired by scanning the item of mail. The scanned information is then used to obtain the correct recipient address and the sender's record of the recipient's address is corrected.

As recited in claim 1 as amended, Applicant's invention is directed to a method for processing undeliverable mail items by encoding data, including recipient identification information, on each of the mail items prior to mailing, receiving those mail items that are returned as being undeliverable, scanning and decoding the encoded data on the items of undeliverable mail to identify intended recipients having incorrect addresses, and electronically transferring to the sender information for the identified intended recipients for the sender to update the sender's mailing address files. As further recited in claim 10, Applicant's invention is directed to a method for processing returned mail items incorporating encoded intended recipient identification

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information by collecting the returned mail items at a processing location, reading the encoded intended recipient identification information from the returned mail items to identify intended recipients having incorrect addresses, electronically gathering updated recipient identification information, including an updated address of the intended recipient, and electronically transmitting updated recipient identification information to the subscriber for updating of a subscriber's address database.

*Sansone, et al.* is directed to a system for metering *incoming deliverable mail* to automatically enable address correction. *Sansone, et al.* teach that a third party, such as a postage meter manufacturer, can collate data, process the data, and use this information to identify delayed mail pieces that may have been incorrectly addressed (col. 2, ll. 3 – 8). To accomplish this, a scanner and control software are connected to a digital postage meter that reads incoming digitally metered mail. The scanner reads already existing postal indicia and other information on the mail piece and extracts the *sender data fields* that are contained in the indicia or on the mail piece. The extracted mail data is periodically uploaded to a data center where the extracted data is compared with mail sender data that has previously been uploaded from sending meters and processors to determine if unexpected delivery delays are caused by incorrectly addressed mail pieces (col. 2, ll. 11 – 22).

Originating mail processors upload pertinent mail piece information on addressees, pointers, or other identifiers automatically and periodically to a data center. The recipient addressee of the mail piece (not the intended mail addressee) temporarily configures his digital postage meter as a postage receiver, so that the postage meter reads the digital postal indicia that was affixed to the

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currently delivered incoming mail (col. 2, ll. 24 – 31). The recipient meter periodically uploads to the data center, raw data on the unique identifiers or codes that have been received. If the received unique identifiers or codes match with the sender unique identifiers or codes in a reasonable amount of time, the sent and receive codes cancel out. Mail pieces that have delivery delays exceeding the norm are used to produce records in the data center. The data center uses these records and additional databases (e.g., the USPS National Change of Address database) to determine whether the mail piece was correctly addressed. If the mail piece was not correctly addressed, the data center corrects the address and reports the correct address to the mailer (col. 2, ll. 33 – 46).

*Sansone, et al*, further teach, at column 4, lines 42 – 55, that an indicia is affixed to the mail piece by a postage meter, the mail piece is then delivered to the post and enters the USPS mail delivery process. The USPS delivers the mail piece to the owner of a recipient electronic postage meter. The incoming mail piece is then scanned by the scanner and processor of the recipient electronic postage meter. The scanned data is segmented into various components and stored for uploading to a central computer. Information from the originating meter regarding the outgoing mail piece was previously sent to the computer for comparison with data uploaded from the recipient meter. That information includes a tracking number (derived from a combination of variables such as meter number, date and time of mailing, etc.), a return address field and an address field, the date and time the mail piece was scanned by the receiving additional postage meter, and the serial number of the meter. This does not represent a teaching of processing of *undeliverable mail items*. Instead, it is a teaching of sending outgoing mail items from a first

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postage meter through the USPS, to a second postage meter to determine processing delays, with the tracking number being used for the purpose of identifying a particular mail item, not to encode recipient identification information.

*Sansone, et al.* fail to teach encoding data, including recipient identification information on mail items prior to mailing; receiving those items of the mail items that are returned as being undeliverable; scanning and decoding the encoded data on the items of undeliverable mail to identify intended recipients and electronically transferring to the sender information for the identified recipients for the sender to update the sender's mailing address files as recited in claim 1. Therefore, claim 1 is not anticipated by *Sansone, et al.* With respect to claim 10, *Sansone, et al.* fail to teach a method for processing returned mail items that incorporate an encoded intended recipient identification information and performs the steps of collecting returned mail items at a processing location; reading the encoded intended recipient identification information from the returned mail items to identify intended recipients having incorrect addresses; electronically gathering updated recipient identification information, including an updated address of the intended recipient; and electronically transmitting updated recipient identification information to the subscriber for updating of the subscriber's address database. Therefore, claim 10 is not anticipated by *Sansone, et al.*

Claims 2 - 4, 7 - 9, and 28 - 31 depend from claim 1 and, therefore, are not anticipated for at least the same reasons that claim 1 is not anticipated by *Sansone, et al.* Likewise, claims 11 - 13, 16 - 18, and 32 - 33 depend from claim 10 and are not anticipated by *Sansone, et al.* for at least the same reasons that claim 10 is not anticipated.

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The Examiner rejected claims 1 – 38, under 35 USC § 102(e) as being clearly anticipated by *Uhl, et al.* (U.S. Pat. No. 6,292,709). This rejection is respectfully traversed.

With regard to claims 1 – 38, the Examiner stated that *Uhl, et al.* disclose a mail processing system that applies both machine readable encoded recipient address information, for example a PDF 417 barcode, and the recipient address information to an item of mail. The item of mail is then placed in a mail delivery system. When an item of mail cannot be delivered as addressed, the item of mail is returned to the sender and the machine-readable recipient information are acquired by scanning the item of mail. The scanned information is then used to obtain the correct recipient address, and the sender's record of the recipient's address is corrected.

*Uhl, et al.* is directed to a method and device for the online processing of mail to be forwarded. *Uhl, et al.* teach incorporating video coding techniques into OCR reading techniques to increase the number of mail items that can be processed online. This occurs in such a way that during the time the mail items spend in a delay loop, additional items that cannot be read by means of the OCR reading technique can be evaluated. Forwarding of the mail and the location to which it is forwarded follows from the forwarding inscription or the name-related and delivery-location related forwarding directories. Names and addresses of recipients, which cannot be recognized automatically by the means of the OCR reader, are incorporated into the online processing as a result of the prioritized video coding (col. 2, l. 62 – col. 3, l. 10). *Uhl, et al.* teach that an envelope is checked to determine if it must be forwarded or sent back (col. 3, ll. 63 – 65). After passing through the optical code recognition and possibly through one or several phases of the video coding system, and following a dictionary comparison, the delivery location for the mail to be checked is



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known (col. 4, ll. 50 - 53). A delivery instruction detection system detects the imprints of the return stamps used by the delivery persons and transmits a signal if such a stamp is recognized. A device for detecting advance instructions detects such advance instructions as "please return to sender if recipient has moved," and sends a signal to the address change system if an advance instruction is detected. For a return of the mail, it is also necessary to read the sender address. This task is taken over by the optical code recognition and video encoding system (col. 4, l. 63 - col. 5, l. 5). The address change system determines the target address for the mail to be checked. If the mail is to be forwarded, the target address is the new address of the recipient. For a return, the address of the sender is the target address of the mail. The target address bar code is affixed with a bar code printer to the mail. In addition, a forwarding instruction in the new address, or the return instruction are printed with a text printer in clear text onto the mail (col. 5, ll. 6 - 14). The mail is then sorted according to its target address and transported to a respective distribution compartment (col. 5, ll. 28 - 30).

*Uhl, et al.* further teach, at col. 8, ll. 12 - 32, that a bar code is affixed to the mail containing the new address of the recipient as target address. The forwarding instruction and the new address, comprising street, house number, and possibly apartment number, zip code, and if there is sufficient space, also the name of the location are printed to the right or left of the old address. This information is printed directly onto the mail, either online in the OCR or in a sorting machine. It is printed in bold, red type, which can still be read by the delivery person, even if the background of the mail is restless. For mail to be returned to the sender, a bar code is affixed to the mail containing the sender's address as a target address. The return notation (e.g., "return to sender") and

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the reason for the return (e.g., "address change") are printed on the right or left of the old address. The sender address itself is not printed again on the envelope.

With respect to claim 1, *Uhl, et al.* fail to teach a method for processing undeliverable mail items comprising the steps of encoding data including recipient identification information on each of a plurality of mail items prior to mailing; receiving those items of the plurality of mail items that are returned as being undeliverable; scanning and decoding the encoded data on the items of undeliverable mail to identify intended recipients; and electronically transferring to the sender information for the identified recipients for the sender to update the sender's mailing address files. Therefore, claim 1 is not anticipated by *Uhl, et al.*

With respect to claim 10, *Uhl, et al.* fail to teach a method for processing returned mail items that incorporate an encoded intended recipient identification information and performs the steps of collecting returned mail items at a processing location; reading the encoded intended recipient identification information from the returned mail items to identify intended recipients having incorrect addresses; electronically gathering updated recipient identification information, including an updated address of the intended recipient; and electronically transmitting updated recipient identification information to the subscriber for updating of the subscriber's address database. Therefore, claim 10 is not anticipated by *Uhl, et al.*

With respect to claim 24, *Uhl, et al.* fail to teach a system for processing underliverable mail items that includes a scanner for reading optically encoded data including intended recipient identification information on the undeliverable mail; a processor for operation of a computer program for decoding the scanned data, identifying the intended recipient identification information

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in the decoded data, writing the identified recipient identification information into a data file, and transferring to a sender information for the identified intended recipients for the sender to update the sender's mailing address files; and a database for storing the data file containing identified recipient identification information. Therefore, claim 24 is not anticipated by *Uhl, et al.*

Claims 2 - 9 and 28 - 31 depend from claim 1 and are not anticipated for at least the same reasons that claim 1 is not anticipated by *Uhl, et al.* Claims 11 - 18 and 32 - 33 depend from claim 10 and are not anticipated for at least the same reasons that claim 10 is not anticipated by *Uhl, et al.* Claims 25 - 27 depend from claim 24 and are not anticipated for at least the same reasons that claim 24 is not anticipated by *Uhl, et al.*

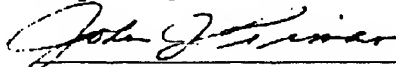
The prior art made of record has been reviewed, but is not deemed to be pertinent to Applicants' invention. More specifically, *Sansone* (U.S. Pat. No. 6,549,892) teaches a system for delivering mail in which each individual recipient is assigned a unique code, information on the mail is read to capture the recipient's name and unique code, the recipient's current delivery address is determined from the recipient's name and unique code, and a mail carrier prints the recipient's current delivery address on the mail if it differs from the delivery address currently in the database, before the mail is delivered to recipient's current delivery address. *Sansone* does not deal with the problem of processing undeliverable, returned mail items. *Sansone* requires the creation of a massive database with each recipient of mail having a unique code and the address of the intended recipient is always checked before an attempt is even made to deliver the mail.

In view of the above, it is submitted that the rejections of the Examiner have been properly addressed and the pending claims are in condition for allowance. Such action at an early date is

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earnestly solicited. It is also requested that the Examiner contact Applicant's undersigned attorney at the telephone number listed below should this response not be deemed to place the application in condition for allowance.

Respectfully submitted,



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11/5/03  
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